

In the event that the Examiner intended to request an election of a fluorophore and a chemical-energy transferring composition, applicants elect:

Fluorophore: xanthene from claim 22; and

Chemical-energy transferring composition: oxalate ester from claim 18.

The elected species read on elected claims 16-29.

The restriction requirement is traversed. The Examiner urges that the common feature of the claims can be found in either the Mahant or Crutchfield patents.

This is the second restriction and the first was improperly based because the common feature was based upon a combination of references and the Examiner agreed that the common feature must lack novelty and cannot be found in a combination of references.

This time the Examiner properly articulates the basis for lack of unity from Rule 1.475(a). However, the grouping of the claims into four groups is still not proper under the law. You cannot use any common feature, find that feature in the prior art and break up the claims. The feature has to be that which when “considered as a whole” marks a contribution over the prior art.

Here, the Examiner notes that the non-fluorescent, non-enzymatic system of creating detectable light using a fluorophore and a chemical-energy transferring

composition (e.g. oxalate) is known and thus cannot be the basis for unity. This is true but it is also irrelevant to the question at hand. You might as well have said that the fluorophores are common to all the claims—they are known and reach the same erroneous conclusion as to unity.

The rules required that the linking concept also be the concept that defines the invention. The linking inventive concept of these claims is the attachment of the fluorophore to a binding partner and using a chemical energy-transferring composition to detect the presence or absence of that binding partner. To the best of our knowledge, no one has used the Crutchfield-type chemistry in this format.

Reconsideration of the restriction requirement is respectfully requested.

CONCLUSION

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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